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ADDRESSEE:

**PETITION** 

FAX: 571-273-8300

SENDER:

Ana Rivera

TOTAL NUMBER OF PAGES INCLUDING LEAD SHEET: 17

DATE:

February 28, 2008

RE:

US Patent Application 09/163,259

ELEVATOR SYSTEM HAVING DRIVE MOTOR LOCATED BETWEEN

ELEVATOR CAR AND HOISTWAY SIDEWALL (Adams et al.)

Our File: OT-4328

I hereby certify that the following document (attached) is being facsimile transmitted to the U.S. Patent and Trademark Office at (571) 273-8300 on February 28, 2008, for filing in the above-referenced application:

• Petition under 37 CFR 1.181(a) to Withdraw Holding of Abandonment (4 pages); and

• Exhibits A-D (12 pages).

Ana Rivera

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FEB 2 8 2008

### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE.

In re application of

Date: February 28, 2008

Frank W. Adams, et al.

Docket No.: OT-4328

Serial No.: 09/163,259

Group No.: 3654

Filed: September 29, 1998

Examiner: Eric E. Pico

Title: ELEVATOR SYSTEM HAVING DRIVE MOTOR LOCATED BETWEEN

ELEVATOR CAR AND HOISTWAY SIDEWALL

Mail Stop Petition Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

### PETITION UNDER 37 CFR 1.181(a) TO WITHDRAW HOLDING OF ABANDONMENT

Sir:

Applicants hereby petition the Commissioner to withdraw the Examiner's holding of abandonment of the present application. This petition does not require a fee. See MPEP 711.03(c).

#### I. Background

Applicants received a Notice of Abandonment dated January 9, 2008 (hereinafter "Notice").

The Notice stated that the present application was abandoned for failure to respond to the Office Action mailed on March 29, 2007 (hereinafter "Office Action").

Applicants did not receive the Office Action at the correspondence address of record.

### II. Showing to Establish Non-Receipt of Office Action

The Intellectual Property Department of Applicants (hereinafter "IP Department") maintains both a physical file (hereinafter "File Wrapper") and an electronic record in a software application (hereinafter "IP Management System") for the present application. As will be shown in detail below, both the File Wrapper and the IP Management System includes at least the following information: patent application number, attorney docket number, mailing date of office actions and due date for responses.

#### A. The File Wrapper

Upon receiving a paper from the Office, the IP Department will date stamp the paper, then add a description of the paper and the mailing date of the paper to the outer jacket of the corresponding file wrapper. Exhibit A provides one panel of the outer jacket of the File Wrapper. The File Wrapper does not include any entry for the Office Action.

The IP Department will then add a docketing stamp to the first page of the paper and insert the appropriate information regarding the paper on the file wrapper. Exhibit B provides a sample of the markings made to a paper received from the Office<sup>2</sup>. Specifically, Exhibit B shows the date stamp and the docketing stamp.

Finally, the IP Department places the paper within the File Wrapper. The undersigned searched the papers in the File Wrapper, and did not uncover the Office Action.

<sup>&</sup>lt;sup>1</sup> The IP Department's docket number for the present application is OT-4328. The Attorney Docket Number appearing in the Office records, 4167-13, was the docket number of the law firm that filed the original papers. The IP Department took over prosecution of this application in 1999 and does not use this docket number.

### B. The IP Management System

In parallel to the aforementioned steps related to the File Wrapper, the IP Department also enters relevant information regarding the paper into the IP Management System. Using an Office Action as an example, the IP Department would add an "Office Action Received" activity to the matter and input the data requested by the software. Exhibit C shows the electronic record for the present application in the IP Management System<sup>3</sup>. The electronic record for the present application does not include any entry for the Office Action<sup>4</sup>.

Once the IP Department enters the particulars of the paper, the IP Management System adds reminders to the docketing list. As with any electronic list, the IP Management System allows the filtering of data in a variety of ways. Exhibit D shows the master docket list for June 29, 2007 (the 3 month due date of the Office Action) with no filters applied<sup>5</sup>. The master docket list does not include any entry for the Office Action.

#### III. Conclusion

In light of the foregoing, Applicants have established that Applicants did not receive the Office Action at the correspondence address of record. Applicants therefore believe the

<sup>&</sup>lt;sup>2</sup> Since Applicants did not receive the Office Action at issue, Applicants obviously cannot show the markings made to that paper.

<sup>&</sup>lt;sup>3</sup> The file number used by the IP Management System (PA-000.04328-US) is slightly different than the docket number of the File Wrapper. The undersigned asserts that they represent the same matter.

<sup>&</sup>lt;sup>4</sup> The IP Department began using the IP Management System in early 2007, so activities prior to that do not appear in the electronic record at this time.

<sup>&</sup>lt;sup>5</sup> Applicants have redacted information related to non-US cases. The Office can see, with the information remaining, that these docket items relate to non-US cases since the IP Management System follows the PCT Country Code format (e.g. JP stands for Japan, WO stands for PCT applications, CN stands for China, etc.).

Commissioner should withdraw the Examiner's holding of abandonment and direct the Examiner to remail the Office Action.

Applicants authorize the Commissioner to charge any fees that may be due in connection with this petition, or to credit any overpayments, to Deposit Account No. 15-0750, Order No. OT-4328.

Respectfully submitted,

Adams et al.

Brian J. Hamilla

Registration No. 38,482

Otis Elevator Company IP Department Ten Farm Springs Farmington, CT 06032 (860) 676-5760

# Exhibit A File Wrapper

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# Exhibit B Sample Paper from Office



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The opinion in support of the decision being entered today was not written for publication and is <u>not</u> binding precedent of the Board.

### UNITED STATES PATENT AND TRADEMARK OFFICE 05 64

## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

04-432h

EX parte FRANK W. ADAMS, LEANDRE ADIFON, PEDRO BARANDA,
MARC CHEVILLIARD, JEAN-NOEL CLOUX,
MASASHI KAWARASAKI, YUTAKA MATSUMOTO,
JEAN-PIERRE MENARD, JEAN-PIERRE POUGNY and
BRUCE ST. PIERRE

Appeal No. 2006-0422 Application No. 09/163,259 MAILED

DEC 15 2006

U.S. PATENT AND TRADEMARK OFFICE BOARD OF PATENT APPEALS AND INTERFERENCES

ON BRIEF

Before FRANKFORT, MCQUADE, and BAHR, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

OTIS IP DEPT...
DOCKETED 1/2/07
ACTION FILE RCE/AMERA
DUE DATE 2/15/07
ATTY SWO

### ON REQUEST FOR REHEARING

Pursuant to 37 CFR § 41.52(a)(1), Frank W. Adams et al. request rehearing of our decision rendered March 28, 2006. In the decision, we sustained the examiner's 35 U.S.C. § 103(a) rejections of claims 1 and 19 as being unpatentable over Aulanko (EP 0 710 618) in view of

## Exhibit C Electronic Record

### **Matter Home**

Matter Overview

**Matter List** 



New Related Matter | New Unrelated Matter | Return to Matter List | Matter Reports | Notes | Country Law | New Invention Disclosure | TM Map Search

Matter

**Edit Matter Audit** 

Title:

Elevator System Having Drive Motor Located Between Elevator Car and

Hoistway ...

File #:

PA-000.04328-US

Type:

Utility - ORG

Country:

United States of America PTO

Parent Org:

United Technologies Corporation

Parent Org File #: **Publication Date:** 

PA-000.04328-US

FIP ID:

203162

Matter Entity Size:

Status:

Pending

Issue Date:

Large

Date Filed: Serial #:

Sep 29, 1998 09/163,259

Patent #:

Inactive Date:

Priority\*:

Yeş

Status Changed Date:

Apr 10, 2003

Created by: CPICONV , Sep 29, 1998 Hosted By; United Technologies Corporation

Details Activities Entities Personnal References Related Matters Ciusters Physical Files Public Messages

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	Miscellaneous Action	Petition for Revival due	Open: Docket Items	Petition for Revival Due : 02/29/2008			Edit	Add <b></b>
	Notice of Abandonment Received		Completed	Date Mailed : 01/09/2008	Date Received : 01/14/2008		Edit	Add
	Miscellaneous Action	Miscellaneous Action - Awaiting Receipt of Notice of Abandonment from PTO expected 12/28/07	Completed	Date Entered : 11/29/2007			Edit	Add
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	Appeal Decision Received	Decision Sustained	Completed	Date Received : 12/19/2006	Date Mailed : 12/15/2006		Edit	Add
	Request Rehearing or Reopen Prosecution	Request rehearing filed.	Completed	Date Done : 05/30/2006			Edit	Add

Matter Overview

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Page 2 of 3

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## Exhibit D Master Docket List

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#### Task Dates

Help

Search:

Task Type:

Assigned To: Anyone

For Countries:

(Except)

Task Status: All

Matter Type: - All --

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Show Assignments: [... Tracked Date Range: Custom

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Start Date 06/29/2007

End Date 06/29/2007

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Docket	Manager

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Application Status Check Due	Status Check Due	Due Date	Jun 29, 2007	Completed
Notes	K) (HK)-C-18	- Docket Task	Application Status Check	
Response to Final Office Action Due	Due - Final Deadline	Final Date	Jun 29, 2007	Completed
Notes	[PA-000.04812-US] [US] Elevator Belt Assembly with Waxless Coating	Docket Task	Amendment and Response to Final Office Action	
Notice of Appeal Due	Appeal Due - Final Deadline	Final Date	Jun 29, 2007	Completed
<u>Nates</u>	[PA-000.04812-US] [US] Elevator Belt Assembly with Waxless Coating	Docket Task	Notice of Appeal	
Pre-Appeal Brief Due	Pre-Appeal Brief Due - Final Deadline [PA-000.04812-US] [US]	Final Date	Jun 29, 2007	Completed
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Payment Due	Payment Due	Final Date	Jun 29, 2007	Completed
<u>Notes</u>	[FR]	Docket Task	A <u>nnuity</u>	
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DS Due	IDS Due	Duo Data	or Ch2)	
	[PA-000.05438-US] [US] Safety Device for Use in an Elevator	Due Date	Jun 29, 2007 _ <u>Info</u> rmation	Completed

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<u>Notes</u>			Statement	
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Payment Due	First Three Years Payment Due	Final Date	Jun 29, 2007	Completed
<u>Notes</u>	(D) (KR] e	Docket Task	Fees	
Voluntary Amendment Due - Advisory Reminder	Voluntary Amendment Due - Advisory Reminder	Reminder	Jun 29, 2007	Completed
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Assign Personnel	Assign Personnel	Due Date	Jun 29, 2007	Open
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<u>Notes</u>	[CN]	Docket Task	New ID matter	
Patent Expected	Date Expected	Reminder	Jun 29, 2007	Completes
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Overall ID Verification	Overall ID Verification	Due Date	Jun 29, 2007	Completed
	[CN]	Process Task	ID Verification	
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